

**REMARKS**

The amendment to claim 31 is for the purpose of clarifying what Applicants regard as the invention. The amendment to claim 41 is to correct a typographical error. No new matter has been added. Because the claim amendments are submitted in revised format, the current requirement in 37 CFR 1.121(c) to provide two versions of claim is therefore waived pursuant to the Notice entitled, "AMENDMENTS IN A REVISED FORMAT NOW PERMITTED", signed January 31, 2003, and posted in the Office's web site.

**I. FINALITY OF OFFICE ACTION**

According to the Office Action, the action is made final. Applicants respectfully submit that a second or any subsequent action on the merits should not be made final where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims. M.P.E.P. 706.07(a). In Applicants' last response, claim 31 was amended to make explicit of what was already inherent in the claim. This type of amendment has been considered by the court in Interactive Pictures v. Infinite Pictures, 274 F.3d 1371 (Fed. Cir. 2001) as non-narrowing in scope. Because Applicants' amendment in the last response essentially rendered the scope of the independent claim 31 unchanged, it should not have necessitated the new ground of rejection presented in this Office Action. Also, according to the Office Action, Applicants' arguments with respect to claim 31 are considered moot in view of the new ground of rejection. Because Applicants' arguments were based on the claim amendment, the fact that Applicants' arguments are considered moot further implicates that the new ground of rejection must not be necessitated by

Applicants' amendment to the claim. For the foregoing reasons, Applicants respectfully submit that the final rejection is premature, and request for reconsideration of the finality of the rejection.

## II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102/103

Claims 31-33, 35, and 37-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,354,295 issued to Guglielmi et al. (Guglielmi). Applicants respectfully note that in order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference.

Claim 31 recites at least one array element having a *contour* that resembles a shape of the aneurysm. Guglielmi does not disclose or suggest such limitation. Rather, Guglielmi discloses a coil 56 deliverable to within an aneurysm 64 as a vaso-occlusive device (Figures 4 and 5). Once delivered within the aneurysm, the coil 56 assumes a random shape to substantially fill up the aneurysm. The overall mass formed by the coil 56 has a shape that resembles the shape of the aneurysm, but the *contour* of the coil 56 itself does not resemble the shape of the aneurysm. Instead, the contour of the coil 56 travels within the aneurysm in a random configuration (See Figures 4, 5, and 8). There is nothing in Guglielmi that discloses or suggests an array element having a *contour* that resembles the shape of an aneurysm. As such, claim 31 is believed allowable over Guglielmi. For at least the reasons that claim 31 is allowable over Guglielmi, the remaining claims 32-44, which depend from claim 31, should also be allowable over the cited references.


CONCLUSION

Based on the foregoing, all claims are believed allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,

Bingham McCutchen LLP

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